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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/050,102	01/18/2002	Norman G. Anderson	2315-150	9065

6449 7590 07/14/2003

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EXAMINER
LU, FRANK WEI MIN

ART UNIT	PAPER NUMBER
1634	

DATE MAILED: 07/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/050,102	ANDERSON ET AL.	
	Examin r	Art Unit	
	Frank W Lu	1634	

-- The MAILING DATE of this communication appears on the cover sh t with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *5/12/2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *52,53 and 57-61* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *52,53 and 57-61* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *1/10/2002 (original)* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Response to Amendment

1. Applicant's response to the office action filed on May 13, 2003 has been entered. The claims pending in this application are claims 52, 53, and 57-61. Rejection and/or objection not reiterated from the previous office action are hereby withdrawn in view of the amendment.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 52 and 57-61 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 23 of U.S. Patent No. 6,340,570 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because the examined claims in this instant application is either anticipated by, or would have been obvious over, the reference claims. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969). Note that, although claim 52 in this instant application is not identical to claim 23 of U.S. Patent No.6,340,570 B1, since claim 23 of U.S. Patent No.6,340,570 B1 teaches an ultracentrifuge tube comprising an upper region, a middle region and a lower region wherein an inner diameter of said upper region is larger than an inner diameter of said middle region and wherein an inner diameter of said middle region is larger than an inner diameter of said lower region wherein at least two different fluids are present, each in different regions and held separately with substantially no diffusion between each before centrifugation and wherein said lower region has a sufficiently small bore to hold an air bubble in it with an aqueous solution below it and in the middle region, claim 23 of U.S. Patent No.6,340,570 B1 are directed to the same subject matter and fall entirely within the scope of claims 52 and 59-61 in this instant application. In other words, claim 52 in this instant application is anticipated by claim 23 of U.S. Patent No. 6,340,570 B1. Since claim 23 of U.S. Patent No.6,340,570 B1 taches to add a sample containing microorganisms to an ultracentrifuge tube,

claims 57 and 58 are anticipated by claim 23 of U.S. Patent No.6,340,570 B1 wherein microorganisms are particles and a sample containing microorganisms is a biological sample.

Response to Arguments

In pages 4 and 5 of applicant's remarks, applicant argues that:" (1) [C]laim 23 of Anderson '570 may be seen to neither teach, disclose, nor suggest an upper region separated from a lower region by a middle region having 1) a decreasing diameter from the upper region toward the lower region, 2) a diameter less than the upper region but greater than the lower region, or 3) a diameter equal to the lower region, as recited in amended claim 52."; (2) "[T]he Applicants request respectfully that they be accorded the benefit of the protections offered by the judicially-created doctrine of double patenting. In particular, the Applicants request the Office Action provide a reason or motivation for a person of ordinary skill in the art at the time the invention was made to have modified claim 23 of Anderson' 570 to amended claim 52."; and (3) "this application and Anderson '570 have the same priority date and thus their patent terms should be the same (not counting patent term extensions). Therefore, it is submitted that there is no purpose for this rejection, since a Terminal Disclaimer would only affirm the identity of the respective patent terms.".

These argument have been fully considered but they are not persuasive toward the withdrawal of the rejection. First, since claim 23 of U.S. Patent No. 6,340,570 B1 teach a ultracentrifuge tube comprising an upper region, a middle region and a lower region wherein an inner diameter of said upper region is larger than an inner diameter of said middle region and wherein an inner diameter of said middle region is larger than an inner diameter of said lower

region, claim 23 of U.S. Patent No. 6,340,570 B1 teach an centrifuge tube having an upper region separated from a lower region by a middle region having a diameter less than the upper region but greater than the lower region as recited in claim 52. In other words, claims 52 in this instant application is anticipated by claim 23 of U.S. Patent No. 6,340,570 B1. Second, the examiner has provided reasons in the office action to explain why claim 52 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 23 of U.S. Patent No. 6,340,570 B1 (see above). Third, the examiner does not require to provide "a motivation for a person of ordinary skill in the art at the time the invention was made to have modified claim 23 of Anderson ' 570 to amended claim 52." since claim 52 in this instant application is anticipated by claim 23 of U.S. Patent No. 6,340,570 B1. Fourth, according to MPEP 37 CFR 1.130(b), when an application claims an invention which is not patentably distinct from an invention claimed in a commonly owned patent with the same or a different inventive entity, a double patenting rejection will be made in the application. A timely filed terminal disclaimer is used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application and is not used to "only affirm the identity of the respective patent terms" which suggests by applicant. Since claim 52 of this instant application is anticipated by claim 23 of U.S. Patent No. 6,340,570 B1, a double patenting rejection is made by the examiner. "this application and Anderson '570 have the same priority date and thus their patent terms should be the same (not counting patent term extensions)." is not the reason for the rejection.

4. Claims 52, 53, and 57-61 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 10 of U.S. Patent No. 6,479,239 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because the examined claims in this instant application is either anticipated by, or would have been obvious over, the reference claims. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969). Note that, although claim 52 in this instant application is not identical to claim 1 of U.S. Patent No.6,479,232 B1, since claim 1 of U.S. Patent No.6,479,232 B1 teaches an ultracentrifuge tube comprising an upper region, a middle region and a lower region wherein an inner diameter of said upper region is larger than an inner diameter of said middle region and wherein (I) an inner diameter of said middle region is larger than an inner diameter of said lower region or (ii) the inner diameter of said middle region is the same as the inner diameter of said lower region, wherein the inner diameter of at least said lower region is small enough to trap an air bubble between two layers of aqueous liquid such that the air bubble will keep said two layers of aqueous liquid separate so long as said centrifuge tube is at rest, claim 1 of U.S. Patent No.6,479,232 B1 are directed to the same subject matter and fall entirely within the scope of claims 52 and 59-61 in this instant application. In other words, claim 52 in this instant application is anticipated by claim 23 of U.S. Patent No. 6,340,570 B1. Since claim 1 of U.S. Patent No.6,479,232 B1 taches to add a sample containing microorganisms to an ultracentrifuge tube, claims 57 and 58 are

anticipated by claim 1 of U.S. Patent No.6,479,232 B1 wherein microorganisms are particles and a sample containing microorganisms is a biological sample. Since claim 10 of US Patent No.6,479,232 B1 teaches identifying the microorganisms recovered, claim 53 of this instant application is anticipated by claim 10 of US Patent No.6,479,232 B1.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

6. No claim is allowed.

7. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official

Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993)(See 37 CAR § 1.6(d)). The CM Fax Center number is either (703) 308-4242 or (703)305-3014.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank Lu, Ph.D., whose telephone number is (703) 305-1270. The examiner can normally be reached on Monday-Friday from 9 A.M. to 5 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Gary Jones, can be reached on (703) 308-1152.

Any inquiry of a general nature or relating to the status of this application should be directed to the patent Analyst of the Art Unit, Ms. Chantae Dessau, whose telephone number is (703) 605-1237.

Frank Lu
July 9, 2003

ETHAN WHISENANT
PRIMARY EXAMINER